

Appln No. 10/735,147

Amdt date April 27, 2005

Reply to Office action of December 29, 2004

#### **REMARKS/ARGUMENTS**

Claims 1-25 remain in the present application, of which claims 1 and 14 are independent. Claims 1, 2, 12, 14 and 15 have been amended herein. Applicants respectfully request reconsideration and allowance of claims 1-25.

#### **I. Objection to the Drawings**

The drawings have been objected to because of FIGs. 4 and 5, which include the reference numeral 116 that does not appear in the specification. We have amended the specification on page 9, lines 3-10 to indicate that the reference numeral 116 designates a flange 116. No new matter has been introduced as those skilled in the art would have recognized that this element designated by the reference numeral 116 is a flange. By way of example, the flange designated by the reference numeral 116 is shown in FIGs. 4-6, and similar or corresponding elements 156, 166 and 176 in FIGs. 7-9, respectively, are referred to as flanges in page 12, line 3 through page 13, line 2 of the specification as filed.

#### **II. Rejection of claim 12 under 35 U.S.C. § 112, Second Paragraph**

Claim 12 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 12 has been amended to depend from claim 4, which provides an antecedent basis for the term "the tapered portion". Therefore, applicants

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request that the rejection of claim 12 under § 112, second paragraph, be withdrawn.

**III. Rejection of claims 1-4, 6-8, 11-18, 20-22 and 25 under 35**

**U.S.C. § 102(b)**

Claims 1-4, 7, 8, 11 and 12 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,518,766 ("Burt"). Further, claims 1, 3, 4, 6-8, 12-14, 16-18, 20-22 and 25 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,086,369 ("Sharp et al."). While the reason for rejecting claim 15 has not been specifically given, applicants will assume that it was rejected over Sharp et al. since the Office Action indicates that all of claims 1-25 have been rejected.

In rejecting claims 1-4, 7, 8, 11 and 12, the Examiner states "Burt shows an ultrasonic dental insert for an ultrasonic dental tool comprising a transducer . . . and a removable tip 31 engaging the engagement portion." However, applicants do not see in Burt any disclosure that the workpiece 31 (of Burt) can be made of plastic. Regarding claim 2, the Examiner notes that the tip (i.e., workpiece 31) may be made of metal.

Further, in rejecting claims 1, 3, 4, 6-8, 12-14, 16-18, 20-22 and 25, the Examiner states "Sharp shows an ultrasonic dental insert for an ultrasonic dental tool comprising . . . a removable tip 16 engaging the engagement portion." However, just as in the case of Burt, applicants do not see any disclosure in Sharp et al. that the tip or the work tool 16 (of Sharp et al.) is made of plastic.

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Claim 1 now recites, in a relevant portion, "[a]n ultrasonic dental insert for an ultrasonic dental tool, comprising . . . a removable tip adapted to engage the engagement portion, wherein the removable tip is made of plastic." (Emphasis Added) Since neither Burt nor Sharp et al. discloses a removable tip made of plastic, Burt and Sharp et al. do not disclose at least one element of claim 1.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicants respectfully submit that Burt and Sharp et al. do not teach every element of claim 1, since the workpiece of Burt and the work tool of Sharp et al. are not made of plastic. Therefore, Burt and Sharp et al. fail to anticipate claim 1, and applicants request that the rejection of claim 1 over Burt and Sharp et al. be withdrawn, and that it be allowed.

Further, applicants submit that the tips for ultrasonic dental tools are conventionally made of metal. There is no motivation anywhere in the cited references to suggest a plastic tip. Thus, it would not have been obvious at the time the invention was made to use a tip made of plastic.

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Similar to claim 1, claim 14 now recites, "[a]n ultrasonic dental unit comprising: an insert comprising: . . . a removable tip adapted to engage the engagement portion, wherein the removable tip is made of plastic." (Emphasis Added) Because of at least the reasons similar to those given above in reference to claim 1, claim 14 is not anticipated by Sharp et al. Therefore, applicants request that the rejection of claim 14 be withdrawn and that it be allowed.

Since claims 2-4, 6-8, 11-13, 15-18, 20-22 and 25 depend, directly or indirectly, from claim 1 or claim 14, they incorporate all the terms and limitations of claim 1 or claim 14 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, applicants request that the rejection of claims 2-4, 6-8, 11-13, 15-18, 20-22 and 25 be withdrawn and that they be allowed.

**IV. Rejection of claims 5, 9, 10, 19, 23 and 24 under 35 U.S.C. § 103(a)**

Claims 5 and 19 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sharp et al. in view of U.S. Patent No. 4,169,984 ("Parisi"). Further, claims 9, 10, 23 and 24 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sharp et al. in view of U.S. Patent No. 4,484,893 ("Finn").

Since claims 5, 9, 10, 19, 23 and 24 depend, directly or indirectly, from claim 1 or claim 14, they incorporate all the terms and limitations of claim 1 or claim 14 in addition to other limitations, which together further patentably distinguish

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them over the cited references. Therefore, applicants request that the rejection of claims 5, 9, 10, 19, 23 and 24 be withdrawn and that they be allowed.

**V. Concluding Remarks**

In view of the foregoing amendments and remarks, applicants respectfully request an early issuance of a patent with claims 1-25. If there are any remaining issues that can be addressed over the telephone, the Examiner is invited to call applicants' attorney at the number listed below.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

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